



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : NAGASHIMA, Toshimichi et al.

Appl. No. : 09/746,054

Filed : December 21, 2000

Title : INFORMATION SUPPLY APPARATUS, INFORMATION UTILIZATION
APPARATUS, INFORMATION MANIPULATION APPARATUS,
INFORMATION SUPPLY SYSTEM, INFORMATION SUPPLY METHOD,
INFORMATION UTILIZATION METHOD AND RECORDING MEDIUM

Examiner : USTARIS, Joseph G.

Art Unit : 2623

Conf. No. : 9861

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FIRST CLASS MAIL CERTIFICATE

I hereby certify that this correspondence is being deposited with the
United States Postal Service as first class mail in an envelope
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Patents, P.O. Box 1450, Alexandria, VA 22313-1450**, on November
13, 2006.

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Name of Applicant, Assignee or Registered Representative

A handwritten signature in dark ink, appearing to read "Thomas F. Presson", written over a horizontal line.

Signature

November 13, 2006

Date of Signature

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants request review of the Final Rejection dated July 11, 2006 in the above-
captioned application. No amendments are being filed with this request. This request is being
filed with a Notice of Appeal. Please consider the reasons stated herein.

REASONS FOR REQUEST

REJECTIONS UNDER 35 U.S.C. §103

As understood by Applicants, Teicher relates to an apparatus for browsing through a motion picture in order to locate desired segments in the motion picture, frames are selected from sequential parts of the motion picture according to predetermined sampling criteria, e.g., "by time", "by tag" or "by change". Each selected frame is reduced in size such that the screen can accommodate the simultaneous display of several frames. The frames are displayed sequentially at sequential locations on the screen according to a predefined closed loop, each frame being displayed in its respective location for a time interval starting with a time delay after the start of the display of the frame at the preceding location in the loop and continuing until the loop has been completed with another frame displayed in its respective location. Thus, only the selected frames need be viewed in order to locate a desired segment, but each selected frame may be viewed for an extended time interval.

In page 4 of the Office Action, the Examiner contends that the server of Teicher's system processes the videos to generate miniaturized frames for each scene change. Applicants respectfully submit that the miniaturized frames of Teicher, however, are not corresponding to the "broadcasting contents information". According to Teicher's figure 2, the image displayed on the screen 18 is divided into nine sub-frames 22, designated A through I. Each sub-frame displays, by its turn and for several seconds, a still image of a miniaturized frame, prepared by and received from frame composer 6 of server 2. Frame composer 6 of server 2 selects and processes these miniaturized frame according to the criteria in figure 4 of Teicher. Selection "by change" instructs sampling criteria detector 10 to identify scene changes in the browsed motion

picture, which exceed a selectable threshold. The measured change relates to the relative percentage of the basic colors (e.g., Red, Green, Blue in an RGB scheme), the threshold being a parameter such as "20%, which implies selecting the first frame where the relative ratio between any of R/G, G/B or B/R changes by more than 20% in respect to the previous selected frame.

Teicher col. 4, lines 29-37. Applicants submit that *Teicher*, however, does not teach or disclose the identified feature in claim 1. Specifically, *Teicher* does not teach or suggest the broadcasting contents information being processed to generate **a child screen for each scene change of said broadcasting contents information.**

Applicants further submit that nothing has been found in *Matthews*, *Iwafune*, *Dunn*, *Thomas*, or *Ellis*, taken alone or combination that would disclose or suggest the above-identified feature of claim 1. Specifically, Applicants respectfully submit that *Matthews*, *Iwafune*, *Dunn*, *Thomas*, and *Ellis* fail to teach or suggest that broadcasting contents information is processed to generate a child screen for each scene change of said broadcasting contents information, as recited in claim 1.

In addition, Applicants respectfully submit that the Office Action has relied on impermissible hindsight. On page 4 of the Office Action, the Examiner asserts that it would have been obvious to one of ordinary skill in the art to combine all these references in order to derive the instant invention. Applicants respectfully submit that the present claims are patentable over the applied references for at least the following reasons.

A. Cited references do not teach all claim recitations

Independent claim 1 recites, *inter alia*:

“... wherein said broadcasting contents information is processed to generate **a child screen for each scene change of said broadcasting contents information** ...” (Emphasis added)

Applicants submit that there is no teaching or suggestion in any of the cited references for the broadcasting contents information being processed to generate a child screen for each scene change of said broadcasting contents information, as recited in instant claim 1. Applicants further submit that the miniaturized frames of Teicher that the Examiner cites, however, are not corresponding to the “broadcasting contents information” as discussed above.

B. No motivation or suggestion to combine cited references

Applicants submit that there is no motivation for one skilled in the art to modify Matthews’ electronic program guide with the features recited in the instant claim, when Matthews does not teach or suggest the use of these special features.

MPEP §2145(X)(c) states:

As discussed in MPEP §2143.01, **there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings.** The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references, as discussed in the aforementioned section. (Emphasis added)

Therefore, Applicants respectfully submit that the Office Action has relied on impermissible hindsight.

C. Impermissible hindsight reasoning and mosaic reconstruction

Applicants respectfully submit that *impermissible hindsight* reconstruction of the claimed invention using elements of the prior art is *not* allowed under 35 U.S.C. §103 (see MPEP §2142 for a discussion of impermissible hindsight).

Furthermore, MPEP §2143.01(III) states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Emphasis in original.)

Applicants respectfully submit that the Office Action has merely created a mosaic of features from the prior art, without either a clear motivation or a suggestion of the desirability of the combination.

For at least this reason of reconstruction based on impermissible hindsight, claim 1 should be allowed.

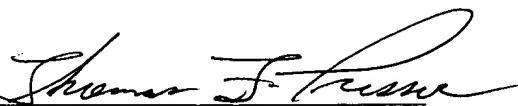
Claims 12, 21-22, and 25-26 are similar, or somewhat similar, in scope to claim 1, and are therefore patentable for similar, or somewhat similar, reasons.

The other claims in this application are each dependent from one of the independent claims discussed above, and are therefore patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

Respectfully submitted,

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